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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,644	05/02/2001	Jared Polis Schutz	Proflowers-P2-01	1018

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PETER K. TRZYNA, ESQ.  
P O BOX 7131  
CHICAGO, IL 60680

EXAMINER
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POPOVICI, DOV

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/847,644

Applicant(s)

POLIS SCHUTZ ET AL.

Examiner

Dov Popovici

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



DOV POPOVICI  
PRIM EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7, 9-11, 17, 19-20, 21, 22-29, 35-39, 45, 47-53, 59-63 and 69-79 are rejected under 35 U.S.C. 102(e) as being anticipated by Barad et al. (US 6,206,750).

With regard to claims 1, 11 and 21, Barad et al discloses a method for generating an ornamental design (see figure 27), the method including the steps of: assigning shipping information signals corresponding to a waybill for a particular shipment with a courier computer shipping apparatus (see figure 4, shipping computer 80); transmitting the shipping information signals corresponding to a non-courier printer device; combining the shipping information signals with signals corresponding to an ornamental design; and printing the waybill including the ornamental design, for the particular shipment at the non-courier printer device (76) including an ornamental design (see figure 4, computer printer 76, and see figure 27).

With regard to claims 7 and 17, Barad et al discloses the step of controlling addition of the design to the shipping label at an ordering system computer (see figure 27 and 4).

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With regard to claims 9 and 19, Barad et al discloses the step of controlling addition of the design to the shipping label at a financial institution system computer (see figure 4, and 27).

With regard to claims 10 and 20, Barad et al discloses the step of controlling addition of the design to the shipping label at a distribution center system (see figures 4 and 27).

With regard to claim 22, Barad et al discloses wherein said at least two members are printed on the same sheet (see figure 27).

With regard to claim 23, Barad et al discloses wherein all said members are printed on the same sheet (see figure 27).

With regard to claim 24, Barad et al discloses the steps of: combining ornamental design signals with signals for printing another member of the group and printing the member of the group, including the ornamental design, for the particular shipment at the shipper printer device (see figures 4 and 27).

With regard to claim 63, Barad et al discloses a method for generating an ornamental design on a courier shipping label at a non-courier printer in connection with printing the label for a particular shipment specified on the label (see figure 27), the method including the steps of: assigning shipping information signals corresponding to a shipping label for a particular shipment with a digital electrical computer shipping apparatus (see figure 4, computers 68 and 78); transmitting the shipping information signals corresponding to the shipping label for the particular shipment to a non-courier printer device (computer printer 66 and 76); combining the shipping information signals

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corresponding to the shipping label for the particular shipment with signals corresponding to an ornamental design (see figure 27); and printing the shipping label for the particular shipment at the non-courier printer device including an ornamental design (see figures 4 and 27).

With regard to claim 69, Barad et al discloses the step of controlling addition of the design to the shipping label at an ordering system computer (see figures 27 and 4).

With regard to claim 70, Barad et al discloses the step of controlling addition of the design to the shipping label at an ordering center system computer (see figures 4 and 27).

With regard to claim 71, Barad et al discloses the step of controlling addition of the design to the shipping label at a financial institution system computer (see figures 4 and 27).

With regard to claim 72, Barad et al discloses the step of controlling addition of the design to the shipping label at a distribution center system (see figures 4 and 27).

With regard to claims 25-29, 35-39, 45, 47-52, 53, 59-62, 69-79, are addressed in the rejections stated above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2-6, 8, 12-16, 18, 30-34, 40-44, 46, 54-58 and 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barad et al. in view of the examiner is taking Official Notice or in view of Applicant's admitted prior art (the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate).

With regard to claims 2-6, 12-16, 30-34, 40-44, 54-58 and 64-68, Barad et al. does not teach wherein the ornamental design includes a heart, a wreath, wherein the ornamental design is printed in color, the ornamental design is a printing of bit map, said bit map not including a logo, shipment, or courier information, wherein the ornamental design is a first design and said first design includes a second design. The examiner is taking official notice or Applicant admitted prior art teaches that an ornamental design includes a heart, a wreath, wherein the ornamental design is printed in color, the ornamental design is a printing of bit map, said bit map not including a logo, shipment, or courier information, wherein the ornamental design is a first design and said first design includes a second design is well known in the art. Therefore, it would have been obvious to one of ordinary skilled in the art to have modified Barad et al. wherein: the ornamental design includes a heart, a wreath, wherein the ornamental design is printed in color, the ornamental design is a printing of bit map, said bit map not including a logo, shipment, or courier information, wherein the ornamental design is a first design and said first design includes a second design. The motivation for doing so would be in

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order to allow a user more design options, including a color option, so as to make the ornamental more attractive, and more personable to the user desire.

With regard to claims 8, 18 and 46, Barad et al. as modified discloses the step of controlling addition of the design to the shipping label at an ordering center system computer (see figures 4 and 27).

### ***Response to Arguments***

Applicant's arguments filed 1/12/2007 have been fully considered but they are not persuasive.

Applicant argues that if the Examiner is contending that Applicant's claimed waybill should be construed to correspond to Barad's entire sheet 82, then Barad has not been shown to be prior art over the September 8, 1998, filing date of the parent application from which the instant case claims priority, e.g., see Fig. 2 of Ser. No. 08/149,650, the originally filed claim 2 (which refers to a "customized element"), and the specification, e.g., at page 8, line 35, which refers to a "graphical image."

First, examiner would like to point out that the wrong serial number was provided in the argument noted above. The correct serial number should be 09/149,650.

Second, when evaluating the priority date for a claim, the priority date is determined based on whether the claimed subject matter was disclosed and taught in the parent application to which priority is claimed. What the prior art shows or does not show is not relevant to this analysis. Claim 1 includes reference to a "waybill", which was not defined or discussed in the parent application to which priority is claimed.

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Accordingly, no priority claim can be accepted for claims including reference to the "waybill", including claim 1.

Additionally, the declaration includes no mention of any priority claims further supporting the contention that applicant does not have support for the priority claims being discussed.

Applicant argues that if the Examiner is instead contending that Applicant's claimed waybill should be construed to correspond to Barad's label 84, as Applicant believes is more appropriate, then Barad does not show the waybill, including the ornamental design. Barad's sheet in Fig. 27 shows label 84, but not Applicant's claimed waybill, including the ornamental design.

Examiner is considering Fig. 27 to read on the waybill. Barad's entire sheet 82 shows a waybill. A waybill according to WEBSTER'S II New Riverside University Dictionary is defined as a document containing a list of goods and shipping instruction relative to a shipment. Barad's entire sheet 82, shown in figure 27, clearly shows a waybill.

With respect to Applicant remarks that the Examiner has also relied on "official notice," and if the rejection is maintained, Applicant hereby requires a reference or the Examiner's declaration, at least so that Applicant can determine whether, under *Graham v. Deem*, there is a proper reason to combine, applicant is directed to MPEP 2144.03.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any



demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate.

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Basically there are three principles here:

(1) If the applicant does not explain why the Officially noticed fact is wrong, you are not required to provide documentation because the argument is inadequate.

(2) If the applicant does not explain why the Official notice is wrong, it is also not persuasive as an argument.

(3) Applicant's failure to explain why the Official Notice is wrong is basis for holding that applicant has admitted the Official Notice feature as being prior art.

#### **Remarks**

It is noted for clarity reason that claims 53-79 are being transferred into this Patent Application, from U.S. Patent Application No. 09/776,956, and not from U.S. Patent Application No. 09/847,644, as mentioned in the remarks section, page 21, lines 1-2, of the amendment filed on 12/5/2005.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moreau (U.S. 4,622,768) teaches printing an ornamental design including a heart (see figures 1-4).

Monaghan (U.S. 5,706,106) teaches printing an ornamental design including a wreath (column 3, line 1 and column 4, lines 15-17).

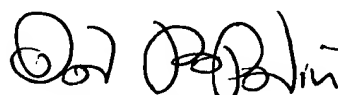
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dov Popovici  
Primary Examiner  
Art Unit 2625